

APPLICANT: AVNER SHAFRIR
SERIAL NO.: 09/583,736
DOCKET NO.: 23452-111

Remarks

Applicants thank the Examiner for the courtesies extended to the Applicants' representative during the personal interview conducted on February 3, 2003.

Applicants further thank the Examiner for acknowledging the claim for domestic priority to a provisional application under 35 U.S.C. § 119(e).

Applicants also thank the Examiner for considering the references cited in the Information Disclosure Statement filed on December 19, 2000, as evidenced by the initialed Form PTO-1449.

Regarding the Information Disclosure Statement filed on April 16, 2002 disclosing co-pending U.S. Patent Applications Nos. 09/580,904 and 09/583,734, the Examiner indicates that he had not considered the content of these applications because the Information Disclosure Statement fails to comply with 37 C.F.R. §1.98(a)(1). Applicants respectfully note that the Examiner appears to have considered at least the content of 09/583,734 because this application forms the basis of the double patenting rejection.

Claims 1-33 are all the claims pending in this application. Claims 30-33 are added by the Amendment. No new matter is included. Attached to this Amendment is Appendix A, which includes a complete set of pending claims and illustrates the marked-up version of the amended specification and claims.

Filed concurrently herewith are a two month extension of time and an excess claim fee payment for the four (4) excess independent claims produced by this Amendment.

Reconsideration and allowance of all of the rejected claims are respectfully requested in view of the foregoing remarks.

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CLAIM REJECTIONS

Claims 1, 4-9, 13-15, 22-23 and 26-29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4-7, 9-11, 13-17 and 19-20 of copending Application No. 09/583,734. Claims 4, 5, 26, and 27 are provisionally rejected under 35 U.S.C. 101 as allegedly claiming the same invention as that of claims 2, 7, 11, 16, and 17 of copending Application No. 09/583,734. Claims 6, 13, and 28 are provisionally rejected under 35 U.S.C. 101 as allegedly claiming the same invention as that of claims 4, 13, and 19 of copending Application No. 09/583,734. Claims 7, 14, and 29 are provisionally rejected under 35 U.S.C. 101 as allegedly claiming the same invention as that of claims 5, 9, 14, and 20 of copending Application No. 09/583,734.

Applicants will consider filing a terminal disclaimer and/or taking any other action necessary to overcome these rejections when the claims are indicated to be otherwise allowable.

Claim Rejection under 35 U.S.C. § 102

Claims 1-29 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Mirabilis ICQ98a, copyright 12/7/97, as shown by ICQ.com website "Sausage Software and Mirabilis Team Up to Bring ICQ to Hotdog Users". Applicants respectfully traverse this rejection on the following basis.

During the personal interview, the Examiner indicated that he is relying on the Mirabilis ICQ98a computer program to support this rejection. The Mirabilis ICQ98a computer program, however, is not provided for review. Rather, the Examiner has provided web page descriptions of the Mirabilis ICQ98a computer program to support his position. Applicants respectfully

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disagree with the Examiner's position and submit that the rejection should be made using only references that are provided for review.

Furthermore, the Examiner asserts that Mirabilis ICQ98a has a copyright date of December 12, 1997. This date is derived from the disclosure in the "What's New" web page alleging that a version of ICQ98a was released on December 12, 1997 (see "What's New", page 3). Since updated versions of ICQ98a were released after December 12, 1997, Applicants respectfully submit that the Examiner may not rely on the December 12, 1997 date to support every feature allegedly provided by ICQ98a. For example, the "What's New" web page discloses that several features of ICQ98a, including status message presets, were released after December 12, 1997 (i.e., on January 4, 1998).

Furthermore, the web page titled "Sausage Software and Mirabilis Team Up to Bring ICQ to Hotdog Users" was located by the "Internet Archive WayBackMachine" at http://www.icq.com/press/press_release25.html. The earliest date that Applicants could find reference to this web page is March 2, 2000 (see Attachment 1 in Appendix B). This date is nine (9) months after Applicants priority date of June 2, 1999. It should be appreciated that, by this response, Applicants have not addressed whether the "Sausage Software and Mirabilis Team Up to Bring ICQ to Hotdog Users" web page anticipates the features recited in claims 1-29. Since the present application is entitled to priority at least to June 2, 1999, Applicants respectfully submit that the Hotdog website cannot be applied as prior art against the claims of the present application. However, Applicants reserve the right to distinguish over the "Sausage Software and Mirabilis Team Up to Bring ICQ to Hotdog Users" web page if and when a disclosure date prior to June 2, 1999 is established.

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For at least the foregoing reasons, withdrawal of this rejection is respectfully requested.

Claim Rejections under 35 U.S.C. §103(a)

Claims 2, 3, 10, 11, 16, 17, 24 and 25 are rejected under 35 U.S.C. §103(a) as allegedly being obvious over Mirabilis ICQ98a, copyright 12/7/97, as shown by ICQ.com website “Sausage Software and Mirabilis Team Up to Bring ICQ to Hotdog Users” in view of Mirabilis ICQ98A, copyright 12/7/97, as shown by “How To Use ICQ”. Claims 6, 7, 13, and 14 are rejected under 35 U.S.C. §103(a) as allegedly being obvious over Mirabilis ICQ98a, copyright 12/7/97, as shown by ICQ.com website “Sausage Software and Mirabilis Team Up to Bring ICQ to Hotdog Users” in view of Mirabilis ICQ98A, copyright 12/7/97, as shown by “ICQ Has Features Consultants Need-And It’s Free”. Claims 4, 5, 26, and 27 are rejected under 35 U.S.C. §103(a) as allegedly being obvious over Mirabilis ICQ98a, copyright 12/7/97, as shown by ICQ.com website “Sausage Software and Mirabilis Team Up to Bring ICQ to Hotdog Users” in view of Mirabilis ICQ98A, copyright 12/7/97, as shown by “Communicate On-line with Your Site Visitors”. Claims 20, 21, 28, and 29 are rejected under 35 U.S.C. §103(a) as allegedly being obvious over Mirabilis ICQ98a, copyright 12/7/97, as shown by ICQ.com website “Sausage Software and Mirabilis Team Up to Bring ICQ to Hotdog Users” in view of Mirabilis ICQ98A, copyright 12/7/97, as shown by “Communicate On-line with Your Site Visitors” and further in view of Mirabilis ICQ98A, copyright 12/7/97, as shown by “ICQ Has Features Consultants Need-And It’s Free”. Claims 12, 18, and 19 are rejected under 35 U.S.C. §103(a) as allegedly being obvious over Mirabilis ICQ98a, copyright 12/7/97, as shown by ICQ.com website “Sausage Software and Mirabilis Team Up to Bring ICQ to Hotdog Users” in view of Mirabilis ICQ98A, copyright 12/7/97, as shown by “How To Use ICQ” and further in view of Mirabilis

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ICQ98A, copyright 12/7/97, as shown by “Communicate On-line with Your Site Visitors”.

Applicants respectfully traverse these rejections on the following basis.

As stated above, the Mirabilis ICQ98a computer program is not provided for review. Rather, the Examiner has provided web page descriptions of the Mirabilis ICQ98a computer program to support his position. Applicants respectfully disagree with the Examiner’s position and submit that the rejection should be made using only references that are provided for review.

Furthermore, Applicants refute the Examiner’s assertion that Mirabilis ICQ98a has a copyright date of December 12, 1997 and submit that the “Sausage Software and Mirabilis Team Up to Bring ICQ to Hotdog Users” web page is not prior art, for the reasons provided above.

Nonetheless, Applicants have amended the claims to further clarify the invention and to expedite their allowance.

Claims 2-7, 9-14, 16-21, and 23-29 depend from corresponding independent claims 1, 8, 15 and 22 and therefore include the recitation of presenting one or more user indicators *as links* within the at least one electronic document, among other things.

In contrast, Mirabilis ICQ98a, as described in “Communicate Online with Your Site Visitors” on page 3 and in “How to Use ICQ” on page 4, provides a separate ICQ communication panel that is displayed as a window *on top of other open applications* on a desktop or as a *floating window* that may be reduced as an icon on the desktop. The “ICQ Status Indicator” web page discloses status buttons that may be presented in a same manner as the ICQ communications panel.

Regarding “ICQ Has Features Consultants Need-And It’s Free”, this reference discloses that ICQ sits dormant in the background or foreground, depending on how you customize the

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application (see Evans, page 1). Thus, "ICQ Has Features Consultants Need-And It's Free" fails to overcome the deficiencies of the above cited references, which fail to disclose or suggest presenting one or more user indicators *as links* within the at least one electronic document.

Thus, Applicants submit that the claimed subject matter is distinguished over Mirabilis ICQ98a and the allegedly supporting web pages, which fail to disclose or suggest presenting one or more user indicators *as links* within the at least one electronic document.

In view of the foregoing differences, Applicants respectfully submit that claims 2-7, 9-14, 16-21, and 23-29 are allowable at least by virtue of their dependency.

New claims 30-33 are added to further define the features disclosed in the originally filed application and are believed to be allowable.

If the Examiner believes that a telephone conference or interview would advance prosecution of this application in any manner, the undersigned attorney stands ready to conduct such a conference at the convenience of the Examiner.

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In the event that it is determined that additional fees are due, the Commissioner is hereby authorized to charge the undersigned's Deposit Account No. 50-0311.

Dated: March 10, 2003

Respectfully submitted,



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